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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,066	06/30/2000	Mekbib Astatke	0942.4990001/RWE/CEJ	1120
26111	7590	11/05/2003	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CHAKRABARTI, ARUN K	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/608,066

Applicant(s)

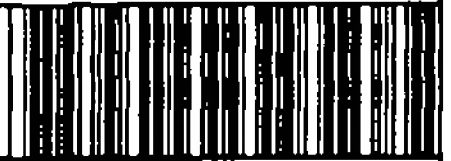
Astatke

Examiner

Arun Chakrabarti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) ☒ Responsive to communication(s) filed on Sep 17, 2003

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4) ☒ Claim(s) 81 and 82 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 81 and 82 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6) ☒ Other: *Detailed Action*

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 17, 2003 has been entered.

### ***Specification***

2. Claims 81 and 82 have been amended.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

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commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 81 and 82 are rejected under 35 U.S.C. 103(a) as being obvious over Goff et al. (U.S. Patent 4,943,531) (July 24, 1990) in view of Arnold et al. (Nature, (1992 May 7), Vol. 357 (6373), pages 85-89).

Goff et al teaches a method of preparing cDNA from mRNA, comprising:  
mixing one or more mRNA templates with one or more reverse transcriptase (pB6B15.23 in this case), and with one or more double stranded nucleic acids (Column 26, lines 23-67); and  
incubating the mixture under conditions sufficient to synthesize one or more cDNA molecules complementary to all or a portion of the templates (Figures 1-2 and Column 26, lines 23-67).

Goff et al teaches a method, wherein the mixing is accomplished under conditions sufficient to prevent nucleic acid synthesis (Column 26, lines 23-67).

Goff et al does not teach a method, wherein a double stranded nucleic acid is allowed to bind to the reverse transcriptase in order to inhibit the nucleic acid synthesis.

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Arnold et al teaches a method, wherein a double stranded nucleic acid is allowed to bind to the reverse transcriptase in order to inhibit the nucleic acid synthesis (Abstract and pages 85-89).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to combine and substitute the method, wherein a double stranded nucleic acid is allowed to bind to the reverse transcriptase in order to inhibit the nucleic acid synthesis of Arnold et al. in the method of Goff et al., since Arnold et al. state, “These results have important implications for developing improved inhibitors of reverse transcriptase for the treatment of AIDS (Abstract, last sentence)”. An ordinary practitioner would have been motivated to combine and substitute the method, wherein a double stranded nucleic acid is allowed to bind to the reverse transcriptase in order to inhibit the nucleic acid synthesis of Arnold et al. in the method of Goff et al. in order to achieve the express advantages, as noted by Arnold et al., of a novel invention which has important implications for developing improved inhibitors of reverse transcriptase for the treatment of AIDS.

#### ***Response to Amendment***

5. In response to amendment, previous 102 (b) rejections have been withdrawn. However, new 103(a) rejection has been included.

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***Response to Arguments***

6. Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D. whose telephone number is (703) 306-5818.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703)308-1119.

Any inquiry of general nature or relating to the status of this application should be directed to the Group LIE Chantae Dessau whose telephone number is (703) 605-1237.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the P.T.O. fax Center located in Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 is (703)872-9306. Please note that the faxing of such papers must conform with the Notice to comply published in the Official Gazette, 1096 OG 30 (November 15,

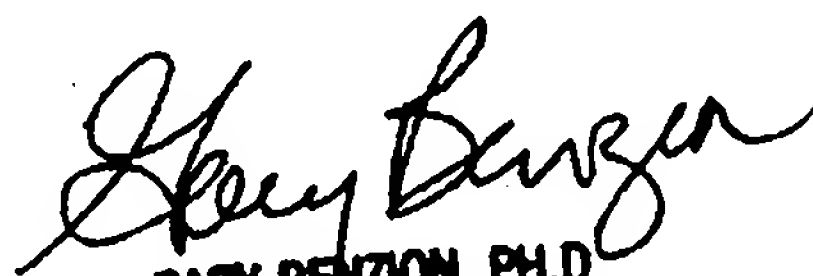
1989).

  
**ARUN K. CHAKRABARTI**  
Arun Chakrabarti **PATENT EXAMINER**

Patent Examiner

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October 13, 2003

  
**GARY BENZION, PH.D.**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**